

JUN 22 2007

REMARKS

Claims 1 and 3-9 stand rejected. Claims 1, 7, and 8 are amended. Claims 10-16 are added. Claim 2 is canceled. Claims 1 and 3-16 remain pending.

Support for the added claims is found in the claims and specification as originally filed. No new matter is added.

112 Rejections:

Claims 1, 7, and 8 are amended to address the Examiner's 112 rejection. Withdrawal of the rejections is requested. These amendments are made for the purpose of addressing the matters of form noted by the Examiner, and do not affect the scope of the claims in any way.

102 Rejections:

Claims 1, 3-4, and 6-8 are rejected as anticipated by Ritchart '486. Claim 1 recites, among other things, an elongated flexible push rod. The Examiner states that Ritchart '486 discloses:

an elongated flexible push rod (61) slidably received within said needle and parallel to said cutter, said push rod extending to the distal end of said needle (column 7, lines 57-67);

It is respectfully urged that this is not a proper characterization of Ritchart '486. First, there does not appear to be any component or feature number "61" in Ritchart that anticipates or even corresponds to a flexible push rod as recited in Claim 1. Ritchart '486 at column 9 describes a "needle pin 61". Ritchart does not teach or suggest that needle pin 61 is flexible, or that needle pin 61 is slidably received in the needle.

Second, Claim 1 also recites a means for advancing the flexible push rod axially toward a distal end the needle. Even if (for the sake of argument only) one assumes that needle pin 61 is a "flexible push rod" the needle pin 61 of Ritchart is fixed relative to the needle 20 of Ritchart. So, it is respectfully urged that Ritchart '486 does not disclose (and would have no reason to disclose) a means for advancing the needle pin 61 toward a distal end of the needle. Further, the portion of Ritchart '486 to which the Examiner refers in making the rejection (column 7, lines 57-67) does not even mention needle pin 61.

Third, Claim 1 also recites a means at the distal end of the needle for causing the flexible push rod to turn 180 degrees thereby reversing its direction. Ritchart '486 does not teach such an element. The Examiner's explanation again refers to column 7, lines 57-67, which as explained above, does not even mention needle pin 61.

With respect to Claim 8, the Examiner states that Ritchart '486 discloses a biopsy instrument as broadly as structurally claimed, and that the specimen tube and cutter are capable of advancing and retracting in unison. It is respectfully urged that anticipation under 35 USC 102 requires that each and every claim element be found in a single prior art reference. It is respectfully urged that the Examiner hasn't shown where in Ritchart '486 the tissue cassette and the cutter 22 move in unison.

The Examiner is requested to consider the description in Ritchart '486 at column 9, lines 16-29, that discloses the cutter 22 is withdrawn through the tissue cassette housing 24. It is respectfully urged that Ritchart '486 does not teach or suggest that the tissue cassette and the cutter 22 move in unison.

Regarding Claim 9, it is respectfully urged that Ritchart '486 does not teach or suggest a flexible push rod, or a flexible push rod slidably received within the needle, for at least the reasons noted above with respect to Claim 1.

Obviousness Rejection:

Claim 5 is rejected as obvious over Ritchart '486. The Examiner's rejection states that it would have been an obvious manner of design choice to modify Ritchart to have a portion of a flexible push rod slidably received in the lower lumen. The Examiner states that the Applicant hasn't disclosed that the push rod being disposed in the lower lumen provides any advantage, is used for a particular purpose, or solves a stated problem.

It is respectfully urged that the Applicant's specification clearly explains that the push rod being disposed in the lower lumen provides an advantage, is used for a purpose, and/or solves a problem. As explained in paragraphs 68, the flexible push rod is advanced distally in the lower lumen, and then deflected around 180 degree curvature back into the upper lumen, thereby pushing the specimen 51 in the proximal direction and into the specimen collection tube. So, while not required, having the push rod slidable in the lower lumen provides the advantage, among other advantages, that the distal end of the flexible push rod can be advance distally in the lower lumen and then be turned around 180 degree curvature to enter the upper lumen and push cut specimen in the desired proximal direction.

New claims:

Regarding new claims 10-16, it is respectfully urged that these claims patentable over the Ritchart '486 reference for all the reasons stated above.

Further, with respect to Claim 10, Ritchart et al. does not teach or suggest a flexible push rod, wherein a portion of the flexible push rod is adapted to move distally within the needle, and wherein an end of the flexible push rod is adapted push a tissue sample in a proximal direction into the hollow cutter.

The Examiner is respectfully requested to reconsider and allow all the pending claims.

Respectfully submitted,

/Gerry Gressel/
Gerry Gressel, reg#34,342

Johnson & Johnson
June 22, 2007
513 337 3535